

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1-4, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,690,175 to Ouchi et al., (hereinafter "Ouchi") in view of U.S. Patent No. 5,916,147 to Boury (hereinafter "Boury"). Additionally, the Examiner rejects claims 5-16 under 35 U.S.C. § 103(a) as being unpatentable over Ouchi and Boury and further in view of U.S. Patent No. 5,084,022 to Claude (hereinafter "Claude").

In response, independent claim 1 has been amended to clarify its distinguishing features. Specifically, claim 1 has been amended to recite:

"a tapered portion linking the small-diameter portion and the large-diameter portion, wherein at least part of the tapered portion is disposed ~~forward an endoscope portion separated 70 cm~~ or less from the distal endoscope end."

The amendment to claim 1 is fully supported in the original disclosure, such as at Figure 6 of the drawings and the accompanying portions of the specification. Thus, no new matter has been introduced into the disclosure by way of the present amendment to independent claim 1. Claims 3 and 4 have also been amended to be consistent with their amended base claim (1).

Turning now to the prior art, Boury does not disclose or suggest that the insertion tube has a tapered portion. Furthermore, Ouchi does not expressly or inherently disclose how distant the tapered portion is disposed from the distal end of the insertion tube.

Therefore, even if the insertion tube of Boury is combined with the tapered portion of Ouchi, such a combination would not suggest to those of ordinary skill in the art to provide such tapered portion 70 cm or less from the distal end of the insertion tube. Thus, the

combination of Ouchi and Boury do not disclose all of the features recited in at least claims 1 and 17.

The Examiner asserts that “Boury teaches that the overall length of the insertion tube may be varied as necessary from about 50-150 cm (Col. 4, Lines 6-20),” concluding that the tapered portion would be located forward an endoscope portion located 45 cm from the distal end.

However, since the insertion tube of Boury is not shown to have a tapered portion and it is not expressly or inherently disclosed how distant the tapered portion of Ouchi is disposed from the distal end of the insertion tube, those of ordinary skill in the art would not look to Boury at all for an insertion tube having a tapered portion, let alone to provide the insertion tube of Boury with a limitation as to the distance of the tapered portion from the distal end.

In contrast, claims 1 and 17 recite at least part of the tapered portion is located 70 cm or less from the distal endoscope end.

Furthermore, such a feature which is not expressly or inherently disclosed in either Ouchi or Boury results in advantages also not disclosed or contemplated by either Ouchi or Boury. Namely, in the claimed invention, at least part of the tapered portion is located at a position 70 cm or less from the endoscope distal end thereby assuring a good insertability while focusing on the fact known from documents that in a case where the distal end portion of the insertion portion inserted in the intestine has reached the cecum by the minimum distance, the distance from the anus to the end surface of the distal end portion is generally about 60 to 70 cm.

That is, by providing a tapered portion in the middle of the flexible portion and providing a small-diameter portion and large-diameter portion at front and rear parts of the tapered portion, respectively as in the claimed invention, operation at the operator side can be easily conveyed to the distal end, thereby improving the insertability into the large intestine.

Moreover, by providing the large-diameter portion on the operator side, the following results in the following two additional advantages. First, the operator is allowed to easily grasp and twist the insertion unit as recited in page 15, lines 5-8 of the specification. Secondly since the operator side of the soft section is made thick, it will hardly warp and can be twisted with less force by a necessary amount, as recited in page 14, lines 10-13 of the specification.

To obtain these two effects, it is necessary that part of the tapered portion is inserted in the large intestine, and for this end, at least part of the tapered portion is disposed 70 cm or less from the distal end portion, as recited in page 13, lines 1-10 and page 14, line 20 to page 15, line 8 of the specification.

Because the position of the tapered portion of Ouchi is not definite and Ouchi does not contemplate the problems and solution thereto recognized by the claimed invention, even if the insertion tube of Boury is combined with the tapered portion of Ouchi, the above described advantageous effect of the claimed invention cannot be obtained if, e.g., Ouchi's tapered portion is disposed at a position 70 cm or more from the distal endoscope end.

Furthermore, by locating at least part of the tapered portion 45 cm or less from the distal endoscope end as recited in claims 3 and 4, the effect is achieved that "as long as at least part of the tapered portion is located forward from the distal end surface of the distal endoscope section by 45 cm, the operator's handling performed on the operator side near the

anus can be smoothly conveyed to the distal section of the insertion unit” as recited in page 13, lines 11-25 of the specification.

Even if the tapered portion of Ouchi is combined with the insertion tube of Boury it is impossible to clearly limit as to at which position of the insertion tube of Boury the tapered portion of Ouchi is disposed and therefore the effect achieved by the claimed invention cannot be obtained.

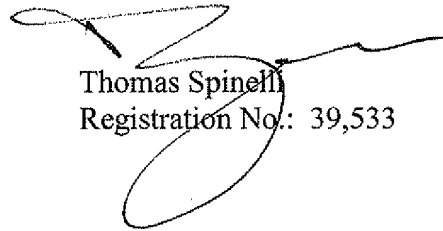
With regard to the rejection of claims 1-4, 17 and 18 under 35 U.S.C. § 103(a), independent claims 1 and 17 are not rendered obvious by the cited references because neither the Ouchi patent nor the Boury patent, whether taken alone or in combination, teach or suggest an endoscope and insertion unit therefore having the features discussed above and recited in independent claims 1 and 17, respectively. Accordingly, claims 1 and 17 patentably distinguish over the prior art and are allowable. Claims 2-4 and 18, being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-4, 17 and 18 under 35 U.S.C. § 103(a).

With regard to the rejection of claims 5-16 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 5-16 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 5-16 under 35 U.S.C. § 103(a).

Furthermore, new claim 20 has been added to further define the patentable invention. New claim 20 is fully supported in the original disclosure, such is at Figure 6 of the Drawings. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 20.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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